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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,757	03/16/2004	Hideo Ando	249710US2SDIV	1347

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EXAMINER	
NGUYEN, HUY THANH	
ART UNIT	**PAPER NUMBER**
2616	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/800,757	ANDO ET AL.	
	Examiner	Art Unit	
	HUY T. NGUYEN	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/15/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 16 directs to information stored on a medium .Since the information do not provide any function interrelationship to the medium to control medium, read out the information and access the information , or impart to any software and hardware structural components to provide certain function that is processed by a computer, the information on the medium do not make them statutory. See MPEP 2100. It is noted that the body of claims contain only non- functional information and there is no means or circuit used for access and control the recited information.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 16-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 of copending Application No. 10/800,681. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 16-19 of the present application and claims 16-19 of copending Application No. 10/800,681 is that claims 16-19 of copending Application No. 10/800,681 recite the cell information further comprises start object entry and end object entry , this recitation not found in claims 16-19 of the present application . However, it is noted that eliminating a part is obvious to one of ordinary skill in the art (See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art t modify claims 16-19 of copending Application No. 10/800,681 by eliminating " start object entry" and " end object entry" from claims 16-19 of copending Application No. 10/800,681 to produce claims 16-19 of the present application .

This is a provisional obviousness-type double patenting rejection.

5. Claims 16-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 of copending Application No. 10/800,626. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the difference between claims 16-19 of the present application and claims 16-19 of copending Application No. 10/800,626 is that claims 16-19 of copending Application No. 10/800,626 recite the cell information further comprises cell general information that contains search information , start object entry and end object entry information , this recitation not found in claims 16-19 of the present application . However, it is noted that eliminating a part is obvious t on of ordinary skill in the art (See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art t modify claims 16-19 of copending Application No. 10/800,626 by eliminating " start object entry" and "end object entry" from claims 16-19 of copending Application No. 10/800,626 to produce claims 16-19 of the present application .

This is a provisional obviousness-type double patenting rejection.

6. Claims 16-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 of copending Application No. 10/800,766. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 16-19 of the present application and claims 16-19 of copending Application No. 10/800,766 is that claims 16-19 of copending Application No. 10/800,766 further recites video information, this recitation not found in claims 16-19 of the present application. However, it is noted that eliminating a part is obvious t on of ordinary skill

in the art (See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art t modify claims 16-19 of copending Application No. 10/800,766 by eliminating video manager information from claims 16-19 of copending Application No. 10/800,626 to produce claims 16-19 of the present application .

This is a provisional obviousness-type double patenting rejection.

7. Claims 16-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 of copending Application No. 10/800,764 in view of Okada et al (6,181,870).

The difference between claims 16-19 of the present application and claims 16-19 of copending Application No. 10/800,764 is that claims 16-19 of copending Application No. 10/800,764 do not recite program chain information that is being recited in claims 16-19 of the present application . However, it is noted that providing the video objects with program chain information to enable of reproducing a plurality of video objects with specified order is well known in the art as taught by Okada (Figs. 70). Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 16-19 of the copending Application No. 10/800,764 with Okada by providing the still picture object units of claims 16-19 of copending Application No. 10/800,764 with a program chain information to enable the still object units can be reproduced with a specified order and to produce claim 16-19 of the present application. .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claim 16-19 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 of copending Application No. 10/800,755 . Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 16-19 of the present application and claims 16-19 of copending Application No. 10/800,755 is that claims 16-19 of the present application further recite the arrangement of the original program chain and user defined program chain with respect to the still picture file that is not found in the claims 16-19 of .that do not recite program chain information having original program chain and user program chain that is being recited in claims 16-19 of copending Application No. 10/800,755. However, it is noted that arrangement original and user-defined program chain after a video object table is well known in the art as taught by Okada (Figs. 70) . Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 16-19 of copending Application No. 10/800,755 by arranging the original and user defined program chain information after the still picture file and to produce the claims 16-19 of the present application..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claim 16-19 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 of copending Application No. 10/800,683 in view of Okada et al (6,181,870).

The difference between claims 16-19 of the present application and claims 16-19 of copending Application No. 10/800,683 is that claims 16-19 of copending Application No. 10/800,683 do not recite program chain information further having user program chain information that is being recited in claims 16-19 of the present application. However, it is noted that providing the video objects with program chain information having user program chain information to enable a user to control of reproducing a plurality of video objects with a user designating order is well known in the art as taught by Okada (Figs. 70). Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 16-19 of copending Application No. 10/800,683 with Okada by providing the still picture object units of copending Application No. 10/800,683 with a user program chain information to enable the still object units can be reproduced with a specified order and to produce claim 16-19 of the present application.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al (6,301,587).

Regarding claims 16-19 , Kim discloses an information storage medium (Figs. 1 and 50 configured to have data recorded thereon and data reproduced therefrom by an information recording/reproducing apparatus, said data including control information and audio/video data having a still picture video object, said medium comprising,

a control information area (column 7, Figs. 1, 3,5, 8) for storing,

still picture audio/video file information table including still picture audio/video file information for managing the still picture video object, and

program chain information including cell information for one of a movie video object of the audio/video data and the still picture video object of the audio/video data, wherein said cell information includes cell general information containing information of a cell type corresponding to the still picture video object, said still picture audio/video file information includes group information of the still picture video object, said group information includes entry information of the still picture video object; and a data area (Fig. 3) for recording the audio/video data is configured to include a sub-picture stream, wherein said entry information includes entry type information containing number

information indicating whether the sub-picture stream (text stream number) is included (column 4, lines 55-68) .

Further for claim 17, Kim teaches method of recording control information and audio/video data on the medium (Figs. 7,8) .

Further for claims 18 and 19, Kim further teaches reproducing apparatus for reproducing the control information and audio/video data from the medium (Fig 7, column 8) .

Response to Arguments

12. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

HUY NGUYEN
PRIMARY EXAMINER